

AUG 3 1953

HAROLD B. WILLEY, Clerk

IN THE

**Supreme Court of the United States**

OCTOBER TERM, A. D. 1953.

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No. 228

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**EMANUEL L. MAZER AND WILLIAM ENDICTER,  
DOING BUSINESS AS JUNE LAMP MANUFACTUR-  
ING COMPANY,***Petitioners,*

vs.

**BENJAMIN STEIN AND RENA STEIN, DOING BUSI-  
NESS AS REGLOR OF CALIFORNIA***Respondents.*

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**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
FOURTH CIRCUIT.**

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## INDEX.

	PAGE
Petition for Writ of Certiorari.....	1
Opinions Below .....	2
Jurisdiction .....	3
Question Presented .....	4
Statutes and Regulations Involved.....	5
Statement .....	6
Errors to be Urged .....	8
Reasons for Granting the Writ.....	9
Conclusion .....	12

### TABLE OF CASES.

Stein v. Benaderet, 109 F.S. 364 (E.D. Mich. S.D. 1952) .....	2, 7
Stein v. Expert Lamp Co. 188 F. (2) 611, (C.C.A. 7, 1951) Certiorari Denied 342 U.S. 629.....	2, 4, 6, 7, 9
Stein v. Expert Lamp Co. 96 F.S. 97 (N.D. Ill. 1951) ..	6
Stein v. Mazer (trial court)—(Opinion Record p. 2-11) —111 F.S. 359.....	2, 7
Stein v. Mazer (Appellate Court)—(Opinion Record p. 35-49) 97 U.S.P.Q. 310.....	2, 4, 8
Stein v. Rosenthal 103 F.S. 227 (S.D. Cal. 1952) affirmed 98 U.S.P.Q. 180.....	2, 6, 7, 8

### STATUTES AND REGULATIONS.

#### DESIGN PATENT STATUTES.

1842—( 5 Stat. 453) (Sec. 3).....	5
1870—(16 Stat. 198) (Sec. 71).....	5
1902—(32 Stat. 193).....	5
1952—(35 U.S.C. 171, 66 Stat. 792).....	5

#### COPYRIGHT STATUTES.

1870—(16 Stat. 198, 212) (Sec. 86).....	5
1874—(Sec. 4952, Revised Statutes).....	5
1909—(35 Stat. 1076, Sec. 5).....	5
1948—17 U.S.C. 5, 61 Stat. 652.....	5

#### COPYRIGHT REGULATIONS.

1926—17 U.S.C.A. West Bound Vol. p. 182.....	5
1950—U.S.C.A. 1, (1952) p. 332-333.....	5

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*To the Honorable the Chief Justice of the  
United States and the Associate Justices  
of the Supreme Court of the United States:*

Petitioners, Emanuel L. Mazer and William Endicter,  
d/b/a June Lamp Manufacturing Co. pray that a writ  
of certiorari issue to review the judgment of the United  
States Court of Appeals for the Fourth Circuit, entered

in the above entitled case on May 19, 1953. The transcript of the record of the case, including the proceedings in the Court of Appeals, is furnished forthwith in accordance with Rule 38 of the Rules of this Court.

### OPINIONS BELOW.

The opinion of the trial court of the United States District Court in Baltimore, Maryland appears in the record page 2. It is reported in 111 F. Supp. 359. The opinion of the Court of Appeals reversing the trial court appears in the record page 35. It is reported in 97 U. S. P. Q. 310.

The prior opinion of the Court of Appeals of the Seventh Circuit with which the opinion of the Court of Appeals of the Fourth Circuit is in direct conflict is *Stein v. Expert*, reported in 188 F. (2) 611, (1951), Certiorari denied 342 U. S. 829. The opinion of the District Court in Chicago, Illinois, which was affirmed by the Court of Appeals of the Seventh Circuit is reported in 96 Fed. Supp. 97.

The same issues were presented and decided in the District Court in Detroit, Michigan in the Sixth Circuit in *Stein v. Benaderet*, reported in 109 Fed. Supp. 364 (1952). An appeal to the Court of Appeals of the Sixth Circuit is presently pending.

The same issues were presented and decided by the District Court in Los Angeles, California in the Ninth Circuit in *Stein v. Rosenthal*, 103 F. S. 227 (1952). On appeal, the defendants admitted the validity of the copyrights involved and the remaining issues were recently affirmed, June 26, 1953. 98 U.S.P.Q. 180.

### **JURISDICTION.**

Jurisdiction is based upon a direct conflict in the judgments of the Courts of Appeals of the Fourth Circuit and the Seventh Circuit.

Jurisdiction is also based upon the fact that in Circuits other than the Fourth and Seventh, and particularly in the Sixth and in the Ninth Circuit, litigation involving the same subject matter and the interpretation of the identical Federal Statutes is involved. The District Court in the Sixth Circuit followed and adopted the decision of the Court of Appeals of the Seventh Circuit. The District Court and the Court of Appeals of the Ninth Circuit rejected it. The uncertainty existing throughout the United States, both in the Bench and the Bar has been reflected in legal commentaries and articles, such as, 66 Harvard L. Rev. 882; 27 Indiana L. J. 131 and 21 George Washington L. Rev. 359.

The importance of the issues here to the Copyright Office of the Library of Congress is pointed out in a brief filed by the Department of Justice as *amicus curiae* for the Fourth Circuit Court of Appeals.

### QUESTION PRESENTED.

The Court of Appeals for the Seventh Circuit has construed the relative scope of the Copyright and Design Patent Laws as follows: *Stein v. Expert*, 188 F. (2) 611, 612.

"We have examined and considered all the cases cited but are not persuaded that a design of an electric lamp may be protected as a monopoly by means of a copyright registration, registered without examination as to originality, novelty or inventiveness."

The Court of Appeals for the Fourth Circuit has considered the relative scopes of the Copyright and Design Patent Laws and has stated (R. 49):

"All that we hold, and all that we need hold, is that the copyrights of the statuettes granted to plaintiffs were valid, even though plaintiffs intended primarily to use the statuettes in the form of lamp bases and did so use them."

The Attorney General of the United States considered the issues important enough to file a brief as amicus curiae before the Court of Appeals for the Fourth Circuit and in the brief stated:

(Page 1):

"This proceeding raises important questions under the Copyright Law and the Rules and Regulations of the Copyright Office.

. . .

(Page 4):

Accordingly, the Register of Copyrights is critically interested in the question raised by these proceedings. The resolution of that question has an important bearing on the operation of the Copyright Office and the effectuation of the objective of the Copyright Law."

The actual question presented is—Can statuettes be protected in the United States by copyright when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity and carried the intentions into effect?

Stripped down to its essentials, the question presented is: **Can a lamp manufacturer copyright his lamp bases?**

### **STATUTES AND REGULATIONS INVOLVED.**

The Statutes involved herein are the Copyright Statutes and the Design Patent Statutes. The Copyright Regulations are also involved. The statutes and regulations are herewith tabulated:

#### **DESIGN PATENT STATUTES.**

- 1842—(5 Stat. 543) (Sec. 3)—page 38 of Record.
- 1870—(16 Stat. 198) (Sec. 71)—page 38-39 of Record.
- 1902—(32 Stat. 193)—page 39 of Record.
- 1952—(35 U.S.C. 171, 66 Stat. 792)—page 39 of Record.

#### **COPYRIGHT STATUTES.**

- 1870—(16 Stat. 198, 212) (Sec. 86) Page 39 of Record.
- 1874—(Sec. 4952, Revised Statutes)—page 40 of Record.
- 1909—(35 Stat. 1076 Sec. 5)—Page 40 of Record.
- 1948—17 U.S.C. 5, 61 Stat. 652—Page 40 of Record.

#### **COPYRIGHT REGULATIONS.**

- 1926—17 U.S.C.A. West Bound Vol. p. 182—page 40 of Record.
- 1950—U.S.C.A. 1, (1952) p. 332-333—page 41 of Record.

**STATEMENT.**

The respondents herein as plaintiffs in 1950 filed a suit in the United States District Court in Chicago, alleging infringement of certain copyrights on statuettes. These statuettes were embodied by respondents as bases in electric table lamps, said lamps being manufactured and sold by respondents in quantity throughout the United States. The District Court in Chicago entered a judgment that the copyrights were invalid and that the subject matter of the copyrights should have been subjects for applications for design patents in the United States Patent Office. The opinion of the District Court was reported in 96 Fed. Supp. 97 (1951).

Respondents appealed to the Court of Appeals for the Seventh Circuit and the judgment of the District Court was affirmed. The opinion is reported in 188 F. (2) 611 (1951). Respondents petitioned for a writ of certiorari, which was denied 342 U.S. 629.

The respondents filed suit on the same copyrights or similar copyrights against other defendants in Los Angeles, Detroit and Baltimore. The identical issues were involved in each of these cases. The second case tried was in the United States District Court in Los Angeles, California. The District Court decided in favor of respondents holding the copyrights valid and infringed. *Stein v. Rosenthal*, 103 F.S. 227 (1952).

Respondent's third case was tried in the District Court in Detroit, Michigan. This involved the identical copyrights as in the California case and the charge of infringement was also predicated on electric table lamps manufactured by the defendant. The District Court in Detroit, after a consideration of the opinions of the District Courts

in Chicago and Los Angeles, and the Court of Appeals of the Seventh Circuit, rendered its opinion and judgment and agreed with the opinion and judgment of the Court of Appeals of the Seventh Circuit in *Stein v. Expert, supra*, and specifically rejected the decision in the California case of *Stein v. Rosenthal, supra*. The complaint was dismissed. *Stein v. Benaderet*, 109 F.S. 364 (1952). This third case is now on appeal by Respondents.

Respondents fourth case was tried in the United States District Court in Baltimore, Maryland, which is the trial court in the case at bar. The suit was based upon similar copyrights, the alleged infringements also being electric table lamps. The trial court below (Judge Coleman), after considering the opinions and decisions of the Courts in the Seventh Circuit and of the District Court in Los Angeles, California, rendered its opinion and judgment in accordance with the opinion and judgment of the Court of Appeals of the Seventh Circuit and specifically rejected the reasoning and decision in the California case. The opinion of the Baltimore District Court, in favor of the Petitioner appears in the record pages 2-11 and is reported in 111 Fed. Supp. 359.

Respondents appealed to the Court of Appeals for the Fourth Circuit and a few days prior to the hearing by the Court of Appeals, The Attorney General of the United States, through the Solicitor for the Library of Congress, filed a brief as amicus curiae and supported the position of respondents. The Court of Appeals for the Fourth Circuit reversed the trial court below and held the copyrights valid and infringed. In its opinion, the Court of Appeals for the Fourth Circuit took direct issue with the Court of Appeals for the Seventh Circuit. The opinion appears in the record pages 35-49.

Subsequent to the opinion in the Fourth Circuit, the Ninth Circuit Court of Appeals on June 26, 1953, affirmed the District Court in the Los Angeles case, 98 U.S.P.Q. 180.

In every one of the above cases, the respondents herein have been the plaintiffs and have initiated the litigation in various parts of the United States. The defendants have been different in the different circuits, but, with the exception of the California case, all the cases have been tried and defended by the same principal counsel herein.

### **ERRORS TO BE URGED.**

1. In holding that a copyright on a statuette is valid even though the applicant for the copyright intended primarily to use the statuettes in the form of lamp bases and did so use them.

2. In failing to hold that a lamp base must be the subject of an application for a design patent rather than an application for copyright in case an applicant desires to secure a Federal monopoly thereon under present Statutes.

3. In holding that a lamp manufacturer may protect the design of an electric table lamp which he intends to and does produce in substantial quantities for sale and obtain a monopoly on the design of such a lamp base under the Copyright Laws rather than under the Design Patent Laws.

4. In failing to hold that a lamp manufacturer who designed a lamp base intending it to be primarily sold as a lamp, and whose first sales were as lamps did not comply with the requirements of the Copyright Act by submitting a statuette as a work of art and relying on the

date of sale of such a lamp as the publication date of the work of art.

5. In reversing the trial court in the Baltimore case and failing to follow the decision of the Court of Appeals in *Stein v. Expert*, 188 F. (2) 611; certiorari denied 342 U.S. 629.

### **REASONS FOR GRANTING THE WRIT.**

The direct conflict in decisions upon identical issues between the Courts of Appeals for the Fourth and Seventh Circuits respectively, and the tendency of District Courts in other parts of the Country to aline themselves in their opinions with either the Court of Appeals for the Fourth Circuit or for the Seventh Circuit creates a situation where the scope and interpretation of the Federal Statutes relating to copyrights and design patents are in fundamental dispute. The Department of Justice in its brief as *amicus curiae* has indicated that the questions involved herein are of fundamental importance to the operation of the Copyright Office of the Library of Congress and to the protection of the rights purported to be granted under the Copyright Statutes by certificates of Copyright. Correlatively the scope and interpretation of the design patent laws as administered by the United States Patent Office is brought into question. Both the Copyright and Patent Offices are presently granting monopolies on table lamps among other things.

Underlying the philosophy of the decision in the Seventh Circuit Court of Appeals is the thesis that copyright laws and design patent laws do not overlap and that the monopoly claimed by respondents herein under the provisions of the Copyright Laws should be subject to the

scrutiny and care exercised by the United States Patent Office in acting upon applications for design patents. The Court of Appeals of the Seventh Circuit felt that a lamp manufacturer who designed artistic bases for electric table lamps and sold them as electric lamps could not create his own monopoly by the pro forma issue of certificates of copyright. These are perfunctorily issued, without examination by the Copyright Office of the Library of Congress, within ten days after filing of same for a period of 28 years upon the payment of a \$4.00 fee. The copyright carries the privilege of renewal for a slight government fee for an additional 28 years. The Court of Appeals felt that the public interest required that such protection could only be given by the United States Patent Office under design patents after the subject matter has been examined as to originality, ornamentation, and invention for a maximum period of 14 years.

The Patent Office has been issuing design patents on such since 1842. The Copyright Office is a newcomer in this field.

The philosophy underlying the opinion of the Court of Appeals for the Fourth Circuit is that copyrights for electric table lamps to be made and sold in quantity are valid. The Court of Appeals for the Fourth Circuit saw no necessity for determining whether there was in fact any conflict or overlap between the Copyright and Design Patent Laws, and that the copyrights were valid and infringed. The self-service effect of the Copyright procedure was not considered to be detrimental to the public interest.

The Attorney General, through the Solicitor for the Library of Congress—no argument on behalf of the Patent Office was presented—argued that copyright protec-

ion was different from design patent protection; that the two laws did overlap and that an applicant could go either to the Copyright Office or to the Patent Office.

The Government brief states (page 3):

"The court below, (trial court) in accord with the Court of Appeals for the Seventh Circuit, *Stein v. Expert Lamp Co.*, 188 F. 2d 611, and the District Court for the Eastern District of Michigan, *Stein v. Benaderet*, 109 F. Supp. 364, but in *conflict* with the District Court for the Southern District of California, *Stein v. Rosenthal*, 103 F. Supp. 227, has held that a work of art which may be, and is, utilized for some practical use may be protected only by design patent and not by copyright."

The Copyright Office has expanded the field of copyrights and issues copyrights on such items as follows:

**From catalog of copyright entries:**

Vol. 1, parts 7-11A Number 2 (July-Dec. 1947)

**"Works of Art"**

Design for button—GU 6636 (p. 89)

Pin up pig bank—GP 6079 (p. 90)

Design for glove bag—GP 6348 (p. 90)

Leather Tooling Design—GP 6742 (p. 91)

Design for bed spread—GP 6155 (p. 91)

Design for puppet stage and packing box combined—  
GU 7061—(p. 91)

Design for sewing selector—GU 6182—(p. 91)

Design for collapsible lamp shade—GU 5903—(p. 93)

Design for cemetery monument—GP 6831—(p. 96)

Doll design—GU 6819—(p. 96)

Bottle opener (metal figurine)—GP 5990—(p. 97)

Models for ash tray—GU 5945—(p. 97)

Designs for lamps—GU 6563—(p. 98)

Design for costume jewelry—GU 7148 (p. 98)  
 Design for hat and for container—GU 6834 (p. 98)  
 Design for game board—GP 6418 (p. 99)  
 Design for metal compact—GU 6709 (p. 100)  
 Model for child's purse—GU 5981 (p. 102)  
 Design for a belt buckle—GP 5923 (p. 105)  
 Ladies purse, billfolds design—GU 6164 (p. 105)

The book of design patents in evidence as Defendant's Ex. 2 illustrates the subject matter of design patents issued by the U. S. Patent Office. Since 1842 the U. S. Patent Office has issued a total of approximately 170,000 design patents.

With the conflict of decisions now present, a copyright owner holding a design for a product, may have it declared invalid in the Seventh Circuit and valid in the Fourth and Ninth Circuits. The Court of Appeals in the Sixth Circuit has yet to be heard from.

Commentators in various law periodicals have recognized that there is a field where copyright and design patent laws appear to be contiguous, with some commentators alleging and others denying that there is an overlap. All agree, however, that confusion is rampant in this field.

### CONCLUSION.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

MAX R. KRAUS,

ROBET L. KAHN,

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Date July 30, 1953

